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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/594,187 | 09/25/2006 | James Van Alstine | PU0418 | 7600 |
| 22840 7590 04/02/2010 GE HEALTHCARE BIO-SCIENCES CORP. PATENT DEPARTMENT 101 CARNEGIE CENTER PRINCETON, NJ 08540 | | | | |
| EXAMINER CHIEU, CHANGHWAJ | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1641 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 04/02/2010 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

melissa.leck@ge.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/594,187

Applicant(s)

VAN ALSTINE ET AL.

Examiner

JACOB CHEU

Art Unit

1641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 March 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-17, 29 and 30.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Jacob Cheu/
Primary Examiner, Art Unit 1641

Continuation of 11, does NOT place the application in condition for allowance because: First, Applicant argues that Gagnon does not discuss anything about the binding capacity, which is the amount of protein that binds to the resin. Applicant also submits that it is indeed possible to have a high retention at the same time as a low capacity (See Remarks at page 7, first paragraph).

Applicant's arguments have been considered, but are not persuasive.

Examiner would like to draw Applicant's attention to the specification of this current application at section 0010-0011 (PG-Publication) where Applicant cites references disclose PEG in combination with chromatography would enhance binding capacity. Moreover, Applicant merely speculate that high retention time may have low binding capacity. In addition, Gagnon et al. disclose that addition of PEG in fact increase the protein retention which is relevant to the binding of protein to the resin column (See Abstract). Absence of concrete evidence to the contrary, the addition of PEG taught by Gagnon may reasonable reach the same binding capacity, e.g. 1.5 fold, since all the essential elements are disclosed and used in the rejection. One ordinary skill in the field would have reasonable expectation to have the similar results.

Second, Applicant also argues Gagnon et al. teach away of using PEG (see page 7, second paragraph). In view of the Gagnon et al. reference, Gagnon et al. in fact teach PEG is a useful component for enhancing the performance of chromatography, particularly for those significant different sizes of overlapping or neighboring proteins (See Conclusion, page 4). One artisan in the art, when viewing the teachings and conclusions, would have optimized the operation of chromatography with addition of PEG.

Taken together, the addition of PEG is known in the art, and would have been obvious to one ordinary skill in the art to combine PEG with other type of chromatography for optimization of separation of proteins.